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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/809,922 | 03/24/2004 | Anthony G. Macaluso | 13817-006001 | 6755 |
| 20985 | 7590 | 01/13/2006 | EXAMINER | |
| FISH & RICHARDSON, PC | | | | SAMS, MATTHEW C |
| P.O. BOX 1022 | | | | ART UNIT |
| MINNEAPOLIS, MN 55440-1022 | | | | PAPER NUMBER |
| | | | | 2643 |

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/809,922 | MACALUSO, ANTHONY G. |
| | Examiner | Art Unit |
| | Matthew C. Sams | 2643 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 April 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-7, 17, 21-24 and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanctis et al. (US 2005/0131837 hereafter, Sanctis).

Regarding claim 1, Sanctis teaches a method for advertising on a mobile device comprising storing an advertisement on a mobile device (Fig. 2 [50, 52, 56, & 58]), initiating a wireless communication involving the mobile device (Fig. 2 [58]) and presenting the advertisement on the mobile device during at least a portion of the wireless communication. (Fig. 3 and Page 6 [0044-0047])

Regarding claim 2, Sanctis teaches downloading the advertisement to the mobile device over a wireless interface. (Fig. 1 [26] and Fig. 2 [58])

Regarding claim 3, Sanctis teaches the wireless communication comprises a download of data to the mobile device. (Fig. 3 [74] and Page 6 [0051])

Regarding claim 4, Sanctis teaches the download of data comprises data used by an application running on the mobile device. (Page 6 [0051])

Regarding claim 5, Sanctis teaches the application comprises a Binary Runtime Environment for Wireless (BREW) application. (Page 5 [0040])

Regarding claim 6, Sanctis teaches the download of data comprises an application file. (Page 6 [0051])

Regarding claim 7, Sanctis teaches presenting the advertisement on the mobile device comprises presenting the advertisement during a delay period, with the delay period representing a time during which the download of data occurs. (Page 8 [0114])

Regarding claim 17, Sanctis teaches an article comprising a machine-readable medium storing instructions causing one or more processors to perform operations (Fig. 1 [10, 11 & 13]) comprising receiving an indication of a wireless data communication involving a mobile device and presenting an advertisement on the mobile device during the wireless communication. (Fig. 2 [52, 56, 58] and Page 5 [0037])

Regarding claim 21, Sanctis teaches the indication of a wireless data communication is received from an application running on the mobile device. (Fig. 3)

Regarding claim 22, Sanctis teaches the application initiates the wireless data communication. (Page 5 [0037-0038])

Regarding claim 23, Sanctis teaches the wireless data communication involves data needed by the application to perform an operation requested by a user of the mobile device. (Page 4 [0033-0035])

Regarding claim 24, Sanctis teaches the application runs on a Binary Runtime Environment for Wireless platform. (Page 5 [0040])

Regarding claim 34, Sanctis teaches a method of advertising on a mobile device comprising storing one or more advertisements on a mobile device (Fig. 2 [50, 52, 56, & 58]), initiating a wireless communication session involving the mobile device (Fig. 2 [58]), and presenting one or more of the advertisements on the mobile device during a period of delay in the wireless communication session. (Fig. 3 and Page 6 [0044-0047])

Regarding claim 35, Sanctis teaches comprising downloading an advertisement to the mobile device over a wireless interface. (Fig. 1 [26] and Fig. 2 [58])

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-16, 18-20, 25-28, 30-33 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanctis in view of Hamano et al. (US 2002/0166127 hereafter, Hamano).

Regarding claim 8, Sanctis teaches determining that the stored advertisement has expired and not showing the advertisement. (Page 8 [0099-0101]) Sanctis differs from the claimed invention by not mentioning sending a notification of the expiration in response to determining the ad expired, but mentions notifying the operator (server) if the advertisement is not shown. (Page 8 [0101]) However, Hamano teaches a system and method for providing advertisements to a wireless terminal that includes

determining if the advertisement has expired and updating the advertisement if required. (Fig. 2, Page 2 [0028] and Page 3 [0033]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the checking of an expiration date and updated if required of Hamano into the method of advertising of Sanctis. One of ordinary skill in the art would have been motivated to do this since it allows the viewer to see the most current and accurate advertisement available and eliminates false hopes that can occur if an expired ad is viewed. (Page 3 [0033])

Regarding claim 9, Sanctis in view of Hamano teaches the notification comprises a request for a new advertisement. (Hamano Page 2 [0028] and Fig. 2)

Regarding claim 10, Sanctis in view of Hamano teaches the stored advertisement has expired based on at least one of an expiration time and a number of times the advertisement is presented. (Hamano Page 2 [0028] and Page 3 [0033])

Regarding claim 11, Sanctis in view of Hamano teaches the notification comprises a request for a new expiration time. (Hamano Page 3 [0032-0033])

Regarding claim 12, Sanctis in view of Hamano teaches receiving a new advertisement in response to the notification. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 13, Sanctis in view of Hamano teaches receiving at least one of an expiration time for the new advertisement and an assigned number of times to present the new advertisement. (Hamano Fig. 2, Page 2 [0028], Page 3 [0032-0033] and Page 6 [Claim 12])

Regarding claim 14, Sanctis in view of Hamano teaches displaying images and websites from the Internet (Hamano Page 1 [0009]), which obviously includes the ability to view bitmaps.

Regarding claim 15, Sanctis in view of Hamano teaches displaying images and websites from the Internet (Hamano Page 1 [0009]), which obviously includes the ability to display advertisements consisting of bitmaps comprising multiple frames shown in a sequential order.

Regarding claim 16, Sanctis in view of Hamano teaches monitoring at least one of a number of times the stored advertisement is presented and a frequency that the stored advertisement is presented. (Hamano Page 6 [Claim 12])

Regarding claim 18, Sanctis teaches determining that the stored advertisement has expired and not showing the advertisement. (Page 8 [0099-0101]) Sanctis teaches notifying the operator (server) if the advertisement is not shown (Page 8 [0101]), but differs from the claimed invention by not mentioning sending a notification of the expiration in response to determining the ad expired. However, Hamano teaches a system and method for providing advertisements to a wireless terminal that includes determining if the advertisement has expired and updating the advertisement if required. (Fig. 2, Page 2 [0028] and Page 3 [0033]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the checking of an expiration date and updated if required of Hamano into the method of advertising of Sanctis. One of ordinary skill in the art would have been motivated to do this since it

allows the viewer to see the most current and accurate advertisement available and eliminates false hopes that can occur if an expired ad is viewed. (Page 3 [0033])

Regarding claim 19, Sanctis in view of Hamano teaches the stored advertisement has expired based on at least one of an expiration time and a number of times the advertisement is presented. (Hamano Page 2 [0028] and Page 3 [0033])

Regarding claim 20, Sanctis in view of Hamano teaches the notification comprises a request for a new expiration time (Hamano Page 3 [0032-0033]) and a request for a new advertisement. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 25, Sanctis in view of Hamano teaches receiving responses from the mobile terminals regarding purchasing requests (Sanctis Page 9 [0117]) and feedback information (Hamano Page 6 [0065]), which obviously allows the service provider to create, maintain and analyze statistical information regarding success rates of advertisements because their success rate would be the best selling point for getting new customers. An example can be seen in Fig. 5 of Patent Application US 2002/0128908 to Levin et al.

Regarding claim 26, Sanctis teaches a communication system comprising a wireless telecommunications network operable to support communications with mobile devices (Fig. 1 [8, 22, 26 & 30]), a central advertising server in communication with the wireless telecommunication network (Fig. 1 [12]) and adapted to store advertisements for presentation on mobile devices during wireless data communications that cause a delay on the mobile devices. (Fig. 1 [14, 16 & 18] & Page 8 [0114]) Sanctis teaches

notifying the operator (server) if the advertisement is not shown (Page 8 [0101]), but differs from the claimed invention by not mentioning receiving a request for a new advertisement. However, Hamano teaches receiving a request for a new advertisement from an advertising application on a mobile device, determining in a new advertisement is available and transmitting the new advertisement to the mobile device. (Fig. 2, Page 2 [0028] and Page 3 [0033]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the receiving a request for a new advertisement of Hamano into the method of advertising of Sanctis. One of ordinary skill in the art would have been motivated to do this since it allows the viewer to see the most current and accurate advertisement available and eliminates false hopes that can occur if an expired ad is viewed. (Page 3 [0033])

Regarding claim 27, Sanctis in view of Hamano teaches receiving responses from the mobile terminals regarding purchasing requests (Sanctis Page 9 [0117]) and feedback information (Hamano Page 6 [0065]), which obviously allows the service provider to create, maintain and analyze statistical information regarding success rates of advertisements because their success rate would be the best selling point for getting new customers. An example can be seen in Fig. 5 of Patent Application US 2002/0128908 to Levin et al.

Regarding claim 28, Sanctis in view of Hamano teaches the statistics relating to advertisements include at least one of a number of times the advertisements have been presented on mobile devices, a number of presentations that have been assigned to mobile devices, a number of requested presentations for each advertisement and an

expiration time for each advertisement. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 30, Sanctis in view of Hamano teaches the central advertising server (Sanctis Fig. 1 [10 & 12]) assigns an expiration time for the selected new advertisement and transmits the assigned expiration time to the mobile device. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 31, Sanctis in view of Hamano teaches the central advertising server is adapted to select the new advertisement according to a priority weighting procedure. (Hamano Page 4 [0042] & Page 6 [Claim 12])

Regarding claim 32, Sanctis in view of Hamano teaches the priority weighting procedure relates to at least one of a remaining number of requested presentations for each advertisement and a time remaining until an expiration time for each advertisement. (Hamano Page 3 [0032-0033], Page 4 [0042] & Page 6 [Claim 12])

Regarding claim 33, Sanctis in view of Hamano teaches the central advertising server (Sanctis Fig. 1 [10 & 12]) can determine if a new expiration time for a current advertisement is available if at least one new advertisement is not available and transmit a new expiration time for the current advertisement if a new expiration time for the current advertisement is available. (Hamano Page 2 [0028], Page 3 [0032-0033], page 4 [0042] & Page 6 [Claim 12])

Regarding claim 36, Sanctis teaches the limitations of claim 34 above, but differs from the claimed invention by not mentioning the period of delay comprises a time during which a download of data occurs. However, Hamano teaches the period of delay

comprises a time during which a download of data occurs. (Page 3 [0037]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the delay of Hamano into the method of advertising on a mobile device of Sanctis. One of ordinary skill in the art would have been motivated to do this since when data is being downloaded, a user has no choice but to wait for the desired program to begin which would be a perfect time to view an advertisement. (Page 3 [0037])

Regarding claim 37, Sanctis in view of Hamano teaches determining one or more of the stored advertisements have expired and sending a notification of the expiration in response to the determination. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

Regarding claim 38, Sanctis in view of Hamano teaches the notification comprises a request for a new advertisement. (Hamano Page 2 [0028] and Fig. 2)

Regarding claim 39, Sanctis in view of Hamano teaches the determination that the stored advertisement has expired is based on at least one of an expiration time and a number of times the advertisement is presented. (Hamano Fig. 2, Page 2 [0028] and Page 3 [0032-0033])

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanctis in view of Hamano as applied to claim 26 above, and further in view of Donian et al. (US 2004/0003398 hereafter, Donian).

Regarding claim 29, Sanctis in view of Hamano teaches a method of advertising on mobile devices that includes an advertising server (Sanctis Fig. 1 [10 & 12]), but

differs from the claimed invention by not mentioning assigning a number of presentations for selected new advertisement and transmit the assigned number to the mobile device. However, Donian teaches assigning a number of presentations for the selected advertisement and transmit the number to the mobile device. (Page 11 [0147]) At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the assignment of a number of viewings for the ad of Donian into the method of advertising on mobile devices of Sanctis in view of Hamano. One of ordinary skill in the art would have been motivated to do this since viewing the same ad multiple times can have the opposite effect and create a negative opinion about the advertised product.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2002/0128908 to Levin et al. regarding a system for conducting user-specific promotional campaigns using multiple communications device platforms.
- US-6,373,498 to Abgrall regarding displaying images during boot-up and shutdown.
- US-6,381,465 to Chern et al. regarding a system and method for attaching an advertisement to an SMS message for wireless transmission.
- US 2001/0032193 to Ferber regarding a system and method for transmission of advertising to wireless devices.
- US 2002/0004855 to Cox et al. regarding systems, methods and computer program products for facilitating display of content within application programs executing on electronic devices.

- US 2004/0117255 to Nemirofsky et al. regarding an interactive electronic commerce and message interchange system featuring delivery of messages tailored to individual users.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Sams whose telephone number is (571)272-8099. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571)272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCS
1/10/2006



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